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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,076	09/21/2001	Christopher Roberts	IMP 1653-002	4747

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EXAMINER

GILLIAM, BARBARA LEE

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/960,076

Applicant(s)

ROBERTS ET AL.

Examiner

Barbara Gilliam

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11 and 18-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5, 18 and 19 is/are allowed.
- 6) ☒ Claim(s) 6, 7, 10, 11, 20 and 22-38 is/are rejected.
- 7) ☒ Claim(s) 8, 9 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed April 15, 2003 has been considered.
2. Claims 2-11, 18-38 are present.
3. The 35 USC 112 rejection is withdrawn.
4. The 35 USC 102(b) rejection over Newman is withdrawn.
5. The 35 USC 103 rejection over Wagner et al is withdrawn.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 20, 22-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,544,370 in view of Wagner et al. and Hackh's.

- a. In US 6,544,370 B1, Roberts et al. claim a method of making a puff image on a fabric article. The method steps are identical to the method steps of the present application with the exception of providing a transfer base material (claims 1-18). It

Art Unit: 1752

would have been obvious to one of ordinary skill in the art to incorporate a transfer base in the method claimed by Roberts et al. based on the teachings of Wagner et al. In US 6,105,502 Wagner et al. teach a reactive ink printing process (abstract). Polymeric binder materials may be incorporated into the ink of Wagner et al. (column 7, lines 1-18). Binder is defined by Hackh's Chemical Dictionary, 3rd Ed. as "a material used to hold solid substances together in a plastic mass." According to the specification of the present application at page 19, lines 3-8, "the transfer base material may be any suitable, conventional, commercially available base material that is adapted for use with transfer applications."

b. Therefore it would have been obvious to one of ordinary skill in the art to incorporate a binder material such as the binder material of Wagner et al. in the method of Roberts et al. wherein the binder is mixed with the puff base plastisol material and each of the at least three pigment concentrates to form at least three transfer compositions with reasonable expectation of obtaining a puff image wherein all the components of the puff image are held together based on the teachings of Wagner et al. and Hackh's Chemical Dictionary, 3rd Ed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1752

9. Claims 6-7, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al. in view of Prawdzik et al.

a. In US Patent No. 4,482,598, Ishii et al teach a transfer sheet for producing decorative articles and a method of making a transfer sheet having foamed convex parts, comprising a substrate having a surface for reliably supporting a pattern thereon and a pattern of material with the ability to foam in the presence of heat, releasably supported upon the surface (claims 1 & 6). The heat-foamable layer comprises a polyvinyl chloride plastisol layer containing a foaming agent (claim 7) which meets the present limitations for the puff base material and the blowing agent respectively. The blowing agents taught include alkaline compounds which also meet the present limitations for a base. A heat foamable ink is prepared by mixing a blowing agent into an ink in which a suitable vehicle is employed and is applied by a known printing method and thus formed into the pattern (column 4, lines 3-10). Examples of vehicles include cellulose derivatives (column 3, lines 23-36). Further to this vehicle a plasticizer, a stabilizer, a dispersant, a filler, a coloring agent of a dye or pigment, a solvent, and a diluent are suitably added (column 4, lines 10-14). The vehicle comprising a plasticizer meets the present limitations for a transfer base material. The coloring agent of a dye meets the present limitations for a pigment concentrate.

b. Ishii et al. clearly teach a release layer comprising a vehicle and a release paint such prepared by further adding silicone, wax, or the like to the vehicle (column 3, lines 17 –22). In US Patent No. 4,689,102, Prawdzik et al teach an improved release medium for used in the production of decorative laminates by both low or high pressure consolidation (abstract). The release coating may comprise a variety of conventional

materials which enable the release medium to readily separate from the adjacent press assembly subsequent to the formation of the laminate and completion of the lamination process. Typically, a silicone-containing layer will be employed as the release coating although various stearates (such as marketed by DuPont under the trademark QUILLON) may be used.

c. It would have been obvious to one of ordinary skill in the art to make a transfer sheet having foamed convex parts, comprising a substrate such as paper with a commercially available release coating such as QUILLON coated thereon and a pattern of material with the ability to foam in the presence of heat, releasably supported upon the surface wherein the heat-foamable layer comprises a polyvinyl chloride plastisol, a blowing agent, a cellulose vehicle, a plasticizer, a coloring agent of a pigment with reasonable expectation of obtaining a transfer sheet that is activated by heat based on the teachings of Ishii et al. and Prawdzik et al.

Response to Arguments

10. Applicant's arguments filed May 15, 2003 have been fully considered but they are not persuasive.

a. Applicant argued there is no motivation to combine the teachings of Ishii et al. and Prawdzik et al. The Examiner disagrees. As pointed out in the rejection, the heat-foamable pattern of Ishii et al. is present on a releasable substrate. Prawdzik et al. teach an improved release medium for used in the production of decorative laminates by both low or high pressure consolidation. Therefore it would have been obvious to use any of the conventional materials which enable the release medium to readily separate

from the adjacent press assembly subsequent to the formation of the foamable pattern and completion of transfer including the stearates marketed by DuPont under the trademark QUILLON based on the teachings of Prawdzik et al.

Allowable Subject Matter

11. Claims 8, 9 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:

a. There is no teaching or suggestion in Roberts et al., Boyd et al., Ishii et al or Prawdzik et al. to incorporate the transfer base material, puff base plastisol and pigment concentrate in the specific amounts required in the present claims.

13. Claims 2-5, 18 and 19 are allowed.

14. The following is an examiner's statement of reasons for allowance:

a. There is no teaching in Roberts et al., Boyd et al., Ishii et al or Prawdzik et al. to incorporate the transfer base material, puff base plastisol and pigment concentrate in the specific amounts required in the present claims.

b. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 703-305-1330. The examiner can normally be reached on Monday through Friday, 8:00 AM - 6:00 PM.

a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone

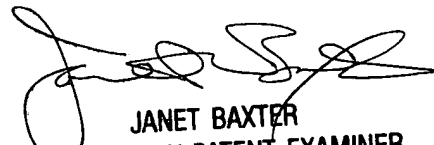
Art Unit: 1752

numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

b. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

B. Gilliam

B. Gilliam
June 30, 2003


JANET BAXTER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700